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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,772	12/24/2004	Ernst Fuchs		6953

60333 7590 08/10/2007  
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EXAMINER
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REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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08/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/519,772

Applicant(s) *EF*

FUCHS, ERNST

Examiner

Annette R. Reimers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-31 is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claims 29 and 30 are objected to because of the following informalities:

"Medially" appears to be misspelled in claims 29 and 30. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-18 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Daily (US Patent Number 5,358,507).

Daily discloses a surgical instrument/kit comprising a plurality of drilling elements, e.g. 10 (see figure 1) having a truncated cone, e.g. at 18, 40, 42 44, 46, 48, with an outer surface line that is smooth and encloses an angle of no more than several degrees with an axis of the truncated cone and a handle, e.g. 14, at an angle to the axis of the truncated cone, wherein the drilling element further comprises an additional truncated cone, e.g. at 16, coaxially contiguous with the truncated cone, the additional

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truncated cone having a top surface that faces a base surface of the truncated cone with the top surface of the additional truncated cone having a larger diameter than a diameter of the base surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and is concave and forms a comparatively sharp cutting edge with a circumferential surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and convex, wherein the angle of the handle to the axis of the truncated cone is approximately 70°, wherein the angle of the handle to the axis of the truncated cone is approximately 80°, wherein the angle of the handle to the axis of the truncated cone is approximately 90°, further comprising means for adjusting the angle of the handle relative to the axis of the truncated cone, e.g. manual adjustment, wherein each the surgical instrument of the plurality of surgical instruments has a fixed and a predetermined angle between the angle of the handle relative to the axis of the truncated cone, with each of the fixed and predetermined angle being graded as a sequence within the plurality of predetermined surgical instruments (see figure 1 and column 3, lines 3-4).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Daily, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 12-21 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Carr (US Patent Number 5,733,119).

Carr discloses various embodiments of a surgical instrument/kit comprising a plurality of drilling elements, e.g. 87 or 115 (see figures 8-10) having a truncated cone with an outer surface line that is smooth and encloses an angle of no more than several degrees with an axis of the truncated cone and a handle, e.g. 22, at an angle to the axis of the truncated cone, wherein the drilling element further comprises an additional truncated cone, e.g. 84 or 112, coaxially contiguous with the truncated cone, the additional truncated cone having a top surface that faces a base surface of the truncated cone with the top surface of the additional truncated cone having a larger diameter than a diameter of the base surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and is concave and forms a comparatively sharp cutting edge with a circumferential surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated

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cone and convex, wherein the angle of the handle to the axis of the truncated cone is approximately 70°, wherein the angle of the handle to the axis of the truncated cone is approximately 80°, wherein the angle of the handle to the axis of the truncated cone is approximately 90°, wherein the angle of the handle relative to the axis of the truncated cone is approximately 100°, further comprising means for adjusting the angle of the handle relative to the axis of the truncated cone, e.g. vibration, wherein the handle is detachably fixed to the drilling element, (see column 1, lines 56-60) wherein each the surgical instrument of the plurality of surgical instruments has a fixed and a predetermined angle between the angle of the handle relative to the axis of the truncated cone, with each of the fixed and predetermined angle being graded as a sequence within the plurality of predetermined surgical instruments (see various embodiments disclosed in figures 1-10).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Carr, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



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Claims 12-21 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuster (US Patent Publication Number 2003/0213343).

Schuster discloses various embodiments of a surgical instrument/kit comprising a plurality of drilling elements having a truncated cone, e.g. see figures 11, 12, and 53-55, with an outer surface line that is smooth and encloses an angle of no more than several degrees with an axis of the truncated cone and a handle, e.g. 50, at an angle to the axis of the truncated cone, wherein the drilling element further comprises an additional truncated cone, e.g. see figures 11, 12 and 53-55, coaxially contiguous with the truncated cone, the additional truncated cone having a top surface that faces a base surface of the truncated cone with the top surface of the additional truncated cone having a larger diameter than a diameter of the base surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and is concave and forms a comparatively sharp cutting edge with a circumferential surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and convex, wherein the angle of the handle to the axis of the truncated cone is approximately 70°, wherein the angle of the handle to the axis of the truncated cone is approximately 80°, wherein the angle of the handle to the axis of the truncated cone is approximately 90°, wherein the angle of the handle relative to the axis of the truncated cone is approximately 100°, further comprising means for adjusting the angle of the handle relative to the axis of the truncated cone, e.g. manual adjustment, wherein

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the handle is detachably fixed to the drilling element, wherein each the surgical instrument of the plurality of surgical instruments has a fixed and a predetermined angle between the angle of the handle relative to the axis of the truncated cone, with each of the fixed and predetermined angle being graded as a sequence within the plurality of predetermined surgical instruments (see various embodiments disclosed in figures 1-57).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Schuster, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daily (US Patent Number 5,358,507) in view of Jorneus et al. (US Patent Number 5,741,267).

Daily discloses the claimed invention except for the markings on the cone. Jorneus et al. disclose a drilling device and teach the use of markings for depth indications to prevent damage to nerves and nerve systems in the jaw (see column 1, lines 24-26 and column 2, lines 50-52). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Daily with markings on the cone, in view of Jorneus et al., as depth indications to prevent damage to nerves and nerve systems in the jaw

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US Patent Number 5,733,119) in view of Jorneus et al. (US Patent Number 5,741,267).

Carr discloses the claimed invention except for the markings on the cone. Jorneus et al. disclose a drilling device and teach the use of markings for depth indications to prevent damage to nerves and nerve systems in the jaw (see column 1, lines 24-26 and column 2, lines 50-52). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Carr with markings on

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the cone, in view of Jorneus et al., as depth indications to prevent damage to nerves and nerve systems in the jaw

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster (US Patent Publication Number 2003/0213343) in view of Jorneus et al. (US Patent Number 5,741,267).

Schuster discloses the claimed invention except for the markings on the cone. Jorneus et al. disclose a drilling device and teach the use of markings for depth indications to prevent damage to nerves and nerve systems in the jaw (see column 1, lines 24-26 and column 2, lines 50-52). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Schuster with markings on the cone, in view of Jorneus et al., as depth indications to prevent damage to nerves and nerve systems in the jaw.

#### ***Allowable Subject Matter***

Claims 27-31 are allowed. Applicant is reminded to correct the misspelling of "medially" in claims 29 and 30.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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